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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,119	06/24/2003	Jorge L. Acosta	51306/695:1	3676

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PSC SCANNING, INC. - STOEL RIVES LLP
C/O STOEL RIVES LLP
900 SW 5TH AVENUE
PORTLAND, OR 97204

EXAMINER	
LEE, SEUNG H	

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/606,119	ACOSTA, JORGE L.	
	Examiner	Art Unit	
	Seung H Lee	2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-37* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 June 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/16/2004*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Prelim. Amdt./Amendment

1. Receipt is acknowledged of the Preliminary Amendment filed on 16 April 2004.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 35 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohkawa et al. (US 5,936,218, cited by applicant)(hereinafter referred to as 'Ohkawa') in view of Small (US 6,297,739).

Ohkawa teaches a scanning system for scanning an item being passed through a scan volume comprising windows (4 and 5), a light source (21), a first mirror system (26) and a second mirror system (27) to produce a two dimensional scan pattern, detectors (28 and 29), a collection system such as a collection lens (32) and a concave mirror (30) for collecting reflected lights and focusing light toward the detectors, a window (5) works as weigh scale, (see Figs. 2-3; col. Col. 9, line 11- col. 12, line 10).

However, Ohkawa fails to teach or fairly suggest that a secondary scanning mechanism is activated when an object is detected on the weigh scale.

Small teaches a system for activating a scanner or an identification sensor (92) when a weigh sensor (72) senses or detects present of the object (see Fig. 1; col. 7, lines 43-55).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Small to the teachings of Ohkawa in order to provide an improved and an enhanced system for activating the both the first and second scanning mechanism for accurate reading of the object presented such as produce, that is, the price of the produce can be calculated precisely using the weigh measured using the weigh scale with the produce code attached on the produce which was read by the scanning mirror system, and therefore an obvious expedient.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 21-34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,585,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 21-34 of the instant application, Applicants claim a system for scanning an item in a scan volume comprising a light source generating a light beam along a beam path, primary scan mirror disposed in the beam path for scanning the light beam over a scan angle in a first scan plane, a secondary scan mirror dithering the light beam over an angle in a second scan plane perpendicular to the first scan plane, the primary scan mirror and the secondary scan mirror scanning the beam to produce a two dimensional scan pattern, a detector, a collection system for collecting return light from reflecting off the item, the collection system, wherein the return light is retrodirectively collected with respect to the primary scan mirror and non-retrodirectively collected with respect to and bypassing the secondary scan mirror.

Claims 1-20 of the U.S. Patent No. 6,585,161 show and disclose a scanning system for scanning an item being passed through a scan volume, comprising a facet wheel containing a plurality of mirror facets and rotating about a rotational axis, a beam generator comprising a light source generating a light beam along a path toward the facet wheel and a beam dithering mechanism for dithering the light beam being directed toward the facet wheel, a detector for detecting return light reflecting off the item being scanned, a collection lens for retrodirectively collecting the return light from the facet

wheel and focusing the return light toward the detector, wherein the beam generator is disposed in the collection lens.

Therefore, as discussed above, the scope of claims 20-34 of the present application and claims 1-20 of U.S. Patent No. 6,585,161 are practically identical.

5. Claim 36 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,585,161 in view of Ohkawa et al. (US 5,936,218) and Small (US 6297,739).

Claims 1-20 of the U.S. Patent No. 6,585,161 show and disclose a scanning system for scanning an item being passed through a scan volume, comprising a facet wheel containing a plurality of mirror facets and rotating about a rotational axis, a beam generator comprising a light source generating a light beam along a path toward the facet wheel and a beam dithering mechanism for dithering the light beam being directed toward the facet wheel, a detector for detecting return light reflecting off the item being scanned, a collection lens for retrodirectively collecting the return light from the facet wheel and focusing the return light toward the detector, wherein the beam generator is disposed in the collection lens.

Ohkawa teaches a scanning system for scanning an item being passed through a scan volume comprising windows (4 and 5), a light source (21), a first mirror system (26) and a second mirror system (27) to produce a two dimensional scan pattern, detectors (28 and 29), a collection system such as a collection lens (32) and a concave mirror (30) for collecting the reflected lights and focusing light toward the detectors, a

window (5) works as weigh scale, (see Figs. 2-3; col. Col. 9, line 11- col. 12, line 10). And, Small teaches a system for activating a scanner or an identification sensor (92) when a weigh sensor (72) senses or detects present of the object (see Fig. 1; col. 7, lines 43-55).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Small and Ohkawa to the teachings of Ohkawa in order to provide an improved and an enhanced system for activating the both the first and second scanning mechanism for accurate reading of the object presented such as produce, that is, the price of the produce can be calculated precisely using the weigh measured using the weigh scale with the produce code attached on the produce which was read by the scanning mirror system, and therefore an obvious expedient.

Allowable Subject Matter

6. Claims 21-34 and 36 would be allowed upon receiving of the Terminal Disclaimer.

7. The following is an examiner's indication of reasons for allowance:

Ohkawa et al. and Small teach a barcode scanning apparatus, but Ohkawa et a. and Small taken alone or combination, fails to specifically teach or fairly suggest that a beam generator of the scanning apparatus is disposed in the collection lens, and the collecting lens are collecting the return light from the facet wheel and focusing the return

light on-axis toward the detector wherein the return light is retrodirectively collected with respect to the facet wheel and non-retrodirectively collected with respect to the dithering mirror as set forth in the claims.

Conclusion

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Seung H. Lee whose telephone number is (571) 272-2401. The examiner can normally be reached on Monday to Friday from 7:30 AM to 4:00 PM.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee, can be reached on (571) 272-2398. The fax-phone number for this group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**seung.lee@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

Seung H. Lee
Art Unit 2876
July 9, 2004

MICHAEL G. LEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800